

DRAWING AMENDMENTS:

As requested, enclosed herewith, please find replacement sheets containing figures 5, 6, and 7. The figures have been provided with better resolution. New matter has not been introduced.

REMARKSGeneral:

The declaration submitted on April 5, 2004 was deemed defective because, according to the Examiner, the declaration did not list all the inventors. For the reasons that follow, Applicant respectfully requests reconsideration.

The drawings were objected to because, according to the Examiner, figures 5, 6, and 7 lack clarity. Applicant has obviated this objection by way of the aforementioned amendments to the drawings. Consequently, Applicant respectfully requests withdrawal of these objections.

Claim 2 was objected to because, according to the Examiner, there is insufficient antecedent basis for the limitation "the angled surface" and the word "fit" should be "fitted." Applicant has obviated this objection by way of the aforementioned amendments to the claims. Consequently, Applicant respectfully requests withdrawal of this objection.

Claim 1 was rejected under 35 U.S.C. § 102(b) because, according to the Examiner, it was anticipated by U.S. Patent No. 6,152,412 to Basickes et al. Applicant has obviated this rejection by way of the aforementioned amendments to the claims. Consequently, Applicant respectfully requests withdrawal of this rejection.

Claim 1 was rejected under 35 U.S.C. § 102(b) because, according to the Examiner, it was anticipated by U.S. Patent No. 5,599,148 to Hirose (hereinafter referred to as "Hirose"). Applicant has obviated this rejection by way of the aforementioned amendments to the claims. Consequently, Applicant respectfully requests withdrawal of this rejection.

Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) because, according to the Examiner, they were anticipated by U.S. Patent No. 6,287,064 to Jhumra et al. (hereinafter referred to as "Jhumra"). Applicant has obviated the rejection of claim 1 by way of the aforementioned amendments to the claims. Consequently, Applicant respectfully requests withdrawal of this rejection. For the reasons that follow, Applicant respectfully requests reconsideration of the rejection of claim 2.

Claim 2 was rejected under 35 U.S.C. § 103(a) because, according to the Examiner, it is unpatentable in view of Hirose. Applicant has obviated this rejection by way of the aforementioned amendments to the claims. For the reasons that follow, Applicant respectfully requests reconsideration of the rejection of claim 2.

A. Applicant requests withdrawal of the requirement to submit a new oath/declaration.

In the Office Action dated December 22, 2004, the Examiner required a substitute oath or declaration. According to the Examiner, "the oath and declaration is defective because it does not list all inventors." The Examiner noted that the declaration submitted on April 5, 2002 listed John Fritch as the sole inventor, while all the documents submitted on November 14, 2003 listed Kent Kallsen as the sole inventor. However, 37 CFR § 1.41, provides:

"the inventorship of a non-provisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in §§ 1.53(d)(4) and 1.63(d). If the oath or declaration prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to 1.53(b) ..."

Applicant respectfully contends that the declaration filed on April 5, 2004 controls the issue of inventorship, since it was filed during the pendency of the present application.

Additionally, the declaration submitted on April 5, 2004 was accurate and properly named John Fritsch as the sole inventor. Consequently, Applicant respectfully requests that the Examiner withdraw the requirement of a supplemental oath or declaration.

B. Applicant requests withdrawal of the 35 U.S.C. § 102(b) rejection of claim 2 as being anticipated by Jhumra.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention. M.P.E.P. § 706.02. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." M.P.E.P. § 2131 (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

Claim 2 recites "a fastener configured to tap threads into the acceptor." Applicant respectfully points out that a rejection under 35 U.S.C. § 102 is appropriate only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Although the Examiner contends that "as a matter of obvious design choice, it would be apparent to those of ordinary skill in the art,

that the fastener (20) could be '*configured*' to thread the acceptor bore to apply a clamping force to either of the two segments," the fact remains that such a teaching is neither expressly nor inherently described in Jhumra. Therefore, the 35 U.S.C. § 102(b) rejection of claim 2 in view of Jhumra is unwarranted, and Applicant respectfully requests reconsideration and withdrawal.

C. Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 2 in view of Hirose.

The legal concept of prima facie obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process. M.P.E.P. § 2142. The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. M.P.E.P. § 2142. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. M.P.E.P. § 2142.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03. "It is essential that office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings." M.P.E.P. § 2144.08, Part II.A. If the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01. When evaluating whether one or more prior art references suggests or teaches all the claim limitations, each prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02. For the reasons that follow, Applicants respectfully request that the rejection of Claims 2 be withdrawn.

Claim 2 recites "a fastener configured to tap threads into the acceptor." According to the Examiner, Hirose discloses all the limitations of claim 2 except for the self-tapping into the acceptor. Although, the Examiner contends that "it would be an obvious matter of engineering design choice, to dimension the retaining and acceptor taught by Hirose, so that either one could be internally threaded by the fastener '*configured*' to tap threads, the fact remains that "a fastener configured to tap threads into the acceptor" is neither taught nor suggested by any of the cited references. For at least this reason, the 103(a) rejection of claim 2 should be withdrawn.

Moreover, according to the Examiner, it would be obvious to modify the retainer (27, 28, and 30) or the acceptor (23, 24, and 26) of Hirose so that either one could be internally threaded by a fastener configured to tap threads; however, clearly, the modification proposed by the Examiner would render the Hirose reference unsatisfactory for its intended purpose, and, as such, there is no suggestion or motivation to make the proposed modification."

In Hirose neither the retainer (27, 28, 30) or the acceptor (23, 24, and 36) contact the stud 8. Instead, the cap member 15 is inserted from the fitting hole 18 onto the stud 8 so as to cover it, the detent pawls 21a of the cap member 15 engage with the thread grooves of the stud 8 so as to non-removably retain the cap member 15 upon the stud 8." Hirose, Col. 3, ll. 28-32. Hirose teaches that "since the plastic cap member is attached to and covers the stud, it is possible to smoothly pass the stud into the through holes of the sheet member without turning up the portions of the sheet metal defining the interior peripheries of the through holes. Thus operability of the sheet member attachment is enhanced." Hirose, Col. 4, ll. 36-42. Consequently, Hirose teaches that the use of the plastic cap member 15 enhances the operability of the sheet member attachment. Clearly, the modification proposed by the Examiner would remove the cap member 15 from the device of Hirose. Such a modification completely changes the principle of operation of Hirose and renders it unsatisfactory for its intended purpose. For at least this reason, the 103(a) rejection of claim 2 should be withdrawn.

Conclusion

Applicants submit that the subject matter of the present application is novel, non-obvious, and useful, and therefore respectfully request prompt consideration and allowance of the present application.

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Respectfully Submitted

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